UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,885	06/27/2003	Robert Keane	MPJ-D1	7851

37420 7590 06/30/2006

VISTA PRINT USA INC.
ATTN: PATENT COUNSEL
100 HAYDEN AVENUE
LEXINGTON, MA 02421

EXAMINER	
GARCIA, GABRIEL I	

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/608,885	KEANE ET AL.	
	Examiner	Art Unit	
	Gabriel I. Garcia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/557,571.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Laverty et al. (6,362,895).

With regard to claim 1, Laverty et al. teaches a computer implemented method for creating an electronic product design (see fig. 3 and fig.4, which depicts how a user can create an electronic product to produce a print design electronically submitted to a print vendor), the method comprising: downloading (e.g. reads on fig. 3, which depicts how the forms or template to make the print order is downloaded or received from a website) one or more product design software tools (see abstract, the software being the modules, fig. 6, depicts a database that stores the software modules (e.g. fig. 4, clearly shows the use of product module (409) and pricing module

(411), the modules being the different software tools to produce and submit the print orders, also see fig. 5, item 460, which clearly depicts the product design software tools) to a user computer (404), the tools being adapted to execute in the browser of the user computer (step 1212, e.g. fig 3 depicts how a user can use computer having a browser being used to access a website and the software modules could be stored in a webserver or downloaded to the user (see fig. 4) or install into the user's computer as suggested in fig. 19a) and allow the user of the user computer to edit a downloaded product design template at the user computer to create a custom product design (e.g. reads on col. 3, lines 1-11, col. 6, lines 20-37, and col. 10, lines 13-27, col. 13, lines 1-15), providing a plurality of template images for viewing by the user of the user computer (e.g. fig. 6 and 8-9, depicts how the user(s) can use the different template of products as shown in fig. 6, line 465, and fig. 8 depicts how different templates are created by a master service as farm services, and fig. 9, depicts the farm service as depicted as different print jobs as (622, 624 and 626, which could be selected by the user from the catalogs products kits (465), the images representing electronic product design templates editable at the computer by the user (e.g. reads on col. 3, lines 1-11, col. 6, lines 20-37, and col. 10, lines 13-27, col. 13, lines 1-15), in response to the user's selection of one of more template images, downloading an editable product design (e.g. reads on fig. 3, which depicts how the forms or template to make the print order is downloaded or received from a website) template associated with the selected template image (see abstract and fig.9), the downloaded product design template being a partially completed product design (reads on figs. 5 and 6, which depicts how the customer is provider with product/design information and fig. 13, depicts how the user is provided with the partially completed electronic product design (see steps 902, 906, 908 and 910, wherein the user is requested for information

to fill the product design form as described in steps 913, and 914), allowing the user to use one or more of the tools to edit the downloaded template to incorporate at the user computer into the downloaded product design template to create a custom electronic product design at the user computer (e.g. reads on col. 3, lines 1-11, col. 6, lines 20-37, and col. 10, lines 13-27, col. 13, lines 1-15).

With regard to claims 2-3, Laverty et al. further teaches wherein the tools are downloaded to the user computer network and allowing the user to upload the electronic product design over the network to a server (see abstract and fig. 4). invisible indicia are printed with a luminescent ink or toner (see page 7).

With regard to claim 4, Laverty et al. further teaches allowing the user to place an order for production of a quantity of a physical product corresponding to the electronic product design (e.g. col. 10, lines 13-27).

With regard to claim 5, Laverty et al. further teaches wherein the tools display the electronic product design to the user in WYSIWYG form (e.g. col. 8, lines 16-31).

With regard to claims 6-7, Laverty et al. further teaches allowing the user to modify at least one feature of the selected product design template or user content during the electronic product design process (e.g. col. 8, lines 9-15).

With regard to claim 8, Laverty et al. further teaches wherein the template images are displayed at a reduced size that allows a plurality images to be simultaneously displayed to the user (e.g. col. 4, lines 4-17).

With regard to claim 16, Laverty et al. further teaches wherein the user is creating an electronic product design for another party (e.g. reads on fig. 4, which depicts how another

person using the computer 404 can place a print order, or the operator of the computer 404, can submit a print order from another person not using the computer).

With regard to claim 17, Laverty et al. further teaches wherein the other party provides product design information for use by the user in connection in creating the product design (reads on fig. 5, item 480).

With regard to claim 18, Laverty et al. further teaches wherein the other party provides at least some product design information via one or more electronic communications (reads on fig. 6, which depicts how a user can submit a job through the internet).

With regard to claim 19, Laverty et al. further teaches wherein the other party provides at least some product design information via one or more voice communications (reads on fig. 6, which inherently teaches that voice or data can be transmitted through the internet).

With regard to claim 20, Laverty et al. further teaches wherein the other party communicates directly with the user (reads on fig. 6, which suggests that other party using the computer can directly connect to the service provide to submit a print order) .

With regard to claim 21, Laverty et al. further teaches wherein the other party communicates with the user via one or more intermediate parties (reads on fig. 4, depicts how the user can communicate to an intermediate server).

With regard to claim 22, Laverty et al. further teaches wherein product design information provided by the other party comprises information identifying the type of product design by the other party (reads on fig. 6, e.g. the product type is equivalent to the catalogs).

With regard to claim 23, Laverty et al. further teaches wherein product design information provided by the other party comprises content that the other party desires be incorporated into an

electronic product design (reads on fig. 6 and fig. 13, the incorporation is being done by the imposition).

With regard to claims 24-25, Laverty et al. further teaches wherein the content comprises text or one or more graphic files (reads on fig. 13, the plotting represent the graphics). .

With regard to claim 26, Laverty et al. further teaches comprising making the created electronic available to the other party (see claim 16 above).

With regard to claim 27, Laverty et al. further teaches wherein product design information provided by the other party comprises one or more requested modifications to the created electronic product design (reads on fig. 13, the user can preview the information before submitting it, allowing the user to make any changes).

With regard to claim 28, Laverty et al. further teaches wherein product design information provided by the other party comprises a request that the user create one or more new electronic designs (see figs. 6 and 9).

With regard to claim 29, Laverty et al. further teaches wherein the product design information by the other party comprises the identification of one or more product design template (reads on fig. 6).

With regard to claim 30, Laverty et al. further teaches wherein the product design information provided by the other party comprises information describing one or more desired modifications to one or more of the one or more identified product design template (see figs 8 and 9, which depicts the different templates).

With regard to claims 9-15 and 31-71, the limitations of claims 9-15 and 31-71 are covered by the limitations of claims 1-8 and 16-30 above. With regard to claims 70-71, Laverty teaches the

user select the features to create the design template creating the design, fig. 3, depict how the template file or preview layout file is stored in the user's computer that allow the user to design the final product and previewing it before submitting the request.

Conclusion

3. Applicant's arguments filed 3/29/06 have been fully considered but they are not persuasive. With regard to Applicant's arguments that Laverty does not teach the downloading one or more product design tool.....and to edit a product design template. Examiner disagrees with Applicant's conclusion. Examiner asserts that Laverty does teach downloading one or more product design tool (e.g. reads on fig. 3, which depicts how the forms or template to make the print order is downloaded or received from a website) .....edit a product design template the product design tools (e.g. reads on, col. 3, lines 1-11, col. 6, lines 20-37, and col. 10, lines 13-27, col. 13, lines 1-15). Clearly fig. 3, depicts how the software or design tool is downloaded to the user's computer by way of the website and fig. 5, depict how this software can be stored in a database. Col. 3, lines 1-11, describe how a master file which is part of the design tool or software being downloaded to be edited or manipulated, col. 6, lines 20-37, describe how the design tool or software can be review or edited. With regard to Applicant's argument that examiner does not address the feature of the user is preparing a product design for another party. Examiner asserts that Laverty teaches wherein the user is creating an electronic product design for another party (e.g. reads on fig. 4, which depicts (or suggests how another person using the computer 404 can place a print order, or the operator of the computer 404, can submit a print order from another person not using the computer).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The Central FAX Number for this group is 571-273-8300.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

GABRIEL GARCIA
PRIMARY EXAMINER

Gabriel I. Garcia
Primary Examiner
June 25, 2006